

JUN 07 2007

Appln. No. 09/752,666
Amendment dated June 7, 2007
Reply to Office Action mailed March 8, 2007

REMARKS

Reconsideration is respectfully requested.

Claims 1, 2, 7 through 12, 14, 15, 17, 18, 21 through 28, 30 through 32 remain in this application. Claims 3 through 6, 13, 16, 19, 20, 29 and 33 through 35 have been cancelled. No claims have been withdrawn or added.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraphs 6 and 7 of the Office Action

Claims 29 and 34 have been objected to for the informalities noted in the Office Action.

Claims 29 and 34 (second occurrence) have been cancelled, and therefore the objection is submitted to be moot.

Paragraphs 8 through 12 of the Office Action

Claims 12 and 35 have been rejected under 35 U.S.C. §112 (second paragraph) as being indefinite.

The above amendments to the claims are believed to clarify the requirements of the rejected claims, especially the particular points identified in the Office Action. More specifically, the language of the claims has been changed to agree with the interpretations set forth in the Office Action.

Withdrawal of the §112 rejection of claims 12 and 35 is therefore respectfully requested.

Appln. No. 09/752,666
Amendment dated June 7, 2007
Reply to Office Action mailed March 8, 2007

Paragraphs 13 through 44 of the Office Action

Claims 1, 2, 7, 8, 14, 15, 17, 18, 21 through 26, 29 through 31 and 32 have been rejected under 35 U.S.C. §102(b) as being anticipated by Adams.

Claim 9 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Adams in view of Lambert.

Claim 10 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Adams in view of Blendermann.

Claim 11 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Adams in view of Porter.

Claims 27 and 28 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Adams in view of Reinhardt.

Claim 1, particularly as amended, requires "wherein the obtaining step is performed after the receiving step and before the storing step". This requirement was previously found in claim 35 (earlier designated as claim 34 before correction). Similarly, but not identically, claim 12 requires "wherein the entering step is performed after the browsing step and before the storing step". Claim 14 requires "said user specified minimum period of time being specified by an entry made at said input device by the user after the data is downloaded and before the data is stored". Claim 32 requires "obtaining, by said client system from the user of the client system and after receiving the data of the individual Web page and before storing the received data, an indication of a minimum length of time during which the received data for the individual Web page is to be temporarily stored on the client system".

Appln. No. 09/752,666
Amendment dated June 7, 2007
Reply to Office Action mailed March 8, 2007

With respect to claim 35, it was alleged in the Office Action that:

44. Claims 34 and 35 are rejected under the same rationale as claim 12. These claims merely specify that the obtaining step (substantially identical to entering step of claim 12) is performed after the receiving step and before the storing step. This would have been obvious for at least the reasons set forth with respect to claim 12.

Turning to the rejection of claim 12, it was conceded in the rejection of the Office Action that:

Adams fails to specifically disclose *the* specific ordering of the steps where the entering step is performed after the browsing step and before the storing step. Rather, Adams discloses that the entering step is performed prior to or simultaneous with the browsing step.

It was then asserted that (emphasis added):

In the absence of unexpected results, it would have been obvious to one of ordinary skill in the art to reverse of the order of steps in the claimed process. For example, in *Ex parts Rubin*, 128 USPQ 440 (Bd. App. 1959), the BPAI held that since 'It is evident therefore that no unexpected result is obtained by reversing the order of steps recited in the method' "the method recited in the appealed claims is not patentable over appellant's patented method." (id., at 442).

This claim is sufficiently similar to the claims at issue in *Ex parts Rubin*. In *Ex parte Rubin*, the claimed method produced a laminated sheet by laminating one side and then putting a metallic film on the other side. It was held to be unpatentable over a claim directed which placed the metallic film on one side prior to laminating the other side. In that case, the product produced was identical, regardless of the order of the steps, and performing them in either order produced no unexpected results.

In this case, the claim states that the entering step is performed after the browsing step and before the storing step. The end result of those steps is receipt of an expiration time from the user, allowing the file to be stored for the specified time. Adams discloses that the entering step is performed prior to or simultaneous with the browsing step (Col 3, Lines 15-17), and before the storing step. The end result of Adams' steps is exactly the same; receipt of an expiration time from the user, allowing the file to be stored for the specified time. There are no unexpected results arising from reversing the order of the entering and browsing steps. Computers are quite predictable and perform only the exact instructions they are told to, and it is apparent that collecting the expiration time from the user prior to or after the browsing step will result in the same outcome, since they are completely independent operations.

However, it is submitted that the order of the entering step with respect to the browsing step and the storing step that is required by the language of claim 1 (and claim 12) is significant and produces results that would not be "expected from the Adams system.

Appln. No. 09/752,666
Amendment dated June 7, 2007
Reply to Office Action mailed March 8, 2007

More specifically, the discussion in Adams requires that “[a]t the time of the request, the user 20 can designate the document as a keep document” (col. 3, lines 15 through 17). However, this requirement requires the user to make the designation as a “keep document” even before the user may know what are the results of the request—e.g., what is the contents of the document. Thus, the user is not able to review the results of the request (e.g., the document) to see if the document is “worth” protecting as a “keep document” before the user is required to designate the document as a “keep document”. This forces the user to evaluate the value of the results of the request before he or she has seen the results of the request, and clearly be inconvenient, and most likely will result in the user designating some documents as “keep documents” that the user finds, after the request has been processed and the document provided, is not worth “keeping”.

In the other embodiment discussed by Adams (col. 5, lines 18 through 20), in which “[k]eep module 30 also allows user 20 to designate any documents *already stored* in disk 18 ... as keep documents” (emphasis added), the document must already be stored on disk before the user can designate it as a “keep document”. This option also can prove to be inconvenient, in that the user must locate and designate the document in order to “keep” the document. One of ordinary skill in the art thus understands that the user is required to save the document before designating it as a “keep document”.

It is submitted that it is not only the “end result” that must be considered. It is noted that the relevant section of the MPEP, section 2144.04(IV)(c), does not mention the consideration of the “end result” as a measure of the obviousness of the order of the steps. It is believed that the manner in which that end results are achieved must also be considered, especially when one is considering the usability of the system and the quality of the experience. The requirement of claim 1 dealing with the

JUN 07 2007

Appln. No. 09/752,666
Amendment dated June 7, 2007
Reply to Office Action mailed March 8, 2007

relative timing of the obtaining step with respect to the receiving and storing step allows, for example, the user to consider the data that has been received, and whether it should be subject to a minimum length of time to be stored, before the data is stored (if the data is stored at all). The user is thus not forced to predict that the data will be worth storing before it has even been received, nor is the user required to save the data before indicating that the data should be stored for a minimum length of time. It is submitted that this produces a more usable result than is disclosed by or evident from the Adams system.

Withdrawal of the §102(b) and §103(a) rejections of claims 1, 2, 7, 8, 12, 14, 15, 17, 18, 21 through 25 and 30 through 32 is therefore respectfully requested.

CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

WOODS, FULLER, SHULTZ & SMITH P.C.



Date: JUNE 7, 2007

Jeffrey A. Proehl (Reg. No. 35,987)
Customer No. 40,158
P.O. Box 5027
Sioux Falls, SD 57117-5027
(605)336-3890 FAX (605)339-3357